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10/648,369	08/27/2003	Yasumi Matsuno	P23835	3704
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EXAMINER YOO, JASSON H				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/648,369

Applicant(s)

MATSUNO ET AL.

Examiner

JASSON H. YOO

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23, 25-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 25-34, 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23, 25-34, 36-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 23, 33, 39 and 41 recite the limitation of "foothold movement". Applicants' specification does not support this limitation. For purposes of this examination, it will be assumed that foothold movements are displayed locations a virtual character can move to. Claims 25-32, 34, 36-38, 40, 42-44 incorporate the limitation by dependency of the claims.

Claim 43 recites the limitation of "a time unit of a virtual concept in the video game is updated in a non-cyclic manner". Applicants' specification does not support this limitation.

Claim 44 recites the limitation of "the rules determined by the rule judge are not repeated as the player character moves between footholds". Applicants' specification does not support this limitation.

Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 44 recites the limitation of "the rules determined by the rule judge are not repeated as the player character moves between footholds". However, independent claim 23 recites the limitation of a rule storage that stores a rule to be set in accordance with the update time unit independently of the foothold to which the player character is moved. The rule judge determines, with reference to the stored rule a rule applicable when the video game advances. If the rules determined by the rule judge are not repeated as the player character moves between footholds, then the rule storage which is used for reference by the rule judge is dependent of the foothold to which the player character is moved. Thus there is a contradiction within the limitations of claim 44.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25-32, 34, 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over NBA Live 96 game manual for Sega Genesis System (1995) (hereinafter "NBA Live").

Claims 23, 24. NBA Live discloses a video game apparatus (page 2 discloses the Sega Genesis Controller, and page 5 discloses the Sega Genesis console to play game stored in the game cartridge), comprising:

a foothold movement instruction input section that inputs an instruction to move a player character (D-Pad allows a player character to move, pages 2-3) between footholds on a map (map of a basketball court as shown in pages, 17, 19, 21, 22)

where a plurality of footholds are arranged (players character can move in a plurality of location in the basketball court);

a foothold movement section that moves the player character between footholds in accordance with the instruction to move the player character between footholds (move player instruction page 2);

a time lapse section that updates a time unit of a virtual concept in the video game when the player character is moved between footholds (The player character can move throughout the length of the game play. The length of the game play can be set by setting the length of the quarter as shown in page 7. This length is updated during the beginning of the quarter. Furthermore, NBA live discloses other time lapse such as "3 in the key", "shot clock", "inbound clock", "half court clock", that are updated as the clock counts up or as the clock counts down.);

a rule storage that stores a rule to be set in accordance with the updated time unit independently of the foothold to which the player character is moved (The rules are stored in the game console's memory, if the rule are set to "ON", page 8. The storage is

set independently of the character movement, because the rules are established at the rule menu, independent of the player character movement.);

a rule judge that determines, with reference to the stored rule (The game program determines if the rules are applicable if they are set "ON" when the game begins, page 8. I.e. Rules such as out of bounds are set at the beginning of the quarter. Rule for such 3 in the key or backcourt are applicable when the character has possession of the ball, page 15.) and in accordance with the updated time unit (All the rules are applicable when the timer for the quarter is running. A 3 second timer is updated for the "3 in the key" rule. When the player has possession of the ball, the 24 second shot clock is updated.), a rule applicable when the video game advances

an instruction input device that inputs an instruction to advance the video game (the player input instruction to move the character throughout the game, page 22);

a rule violation determiner that determines whether the determined rule is violated based on the instruction to advance the video game (The game program determines if the rules listed on page 8 is violated);

a penalty processor that imposes a predetermined penalty when the determined rule is violated (A penalty is imposed on to the player if the player's character violates a rule. It is implied that penalties known the game of basketball are imposed when the rules listed on page 8 are violated. For example, the player will lose possession of the ball, page 15);

NBA Live discloses a game with rules. The player controllers a character to score in one end of the map. The player is also required abide by the rules within the

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map during the game play. NBA discloses the claimed invention as discussed above, but fails to specifically teach the map is a world map. Nevertheless displaying a world map instead of a court map is an aesthetic design change. Aesthetic design changes that do not impact the function of system cannot be relied on to distinguish the claimed subject matter over prior art. Changing the map of the game allows the game to have a different theme. For example, a map of a grassy field may represent a football theme game or a soccer theme game, where the player score points at one end of the field, and required to abide by the rules. A map of world may represent a war theme game where points are achieved by attacking the base at one end of the map and by abiding by the rules. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify NBA Live and incorporate a world map in order to provide a game with a world map theme.

Thus the limitation of a foothold is predetermined location on a world map to which the player character may moved, thereby advancing events in the game is obvious as discussed above. NBA live discloses a map (of a court). The players can move a player character to a predetermined location on the map. By moving the players within the map advances the play of the game. These plays are considered to be events in the game.

NBA Live 96 further discloses the following:

Claim 25. The video game apparatus according to claim 23, further comprising:

an instruction executer that executes processing in accordance with the instruction to advance the video game (gaming apparatus Sega Genesis processes the game instruction stored in game cartridge),

wherein the rule violation determiner determines whether a result of the processing executed in accordance with the instruction to advance the video game is against the determined rule (see rejection for claim 23 above).

Claim 26. The video game apparatus according to claim 23,
wherein the rule applicable when the video game advances is divided into multiple groups (each rule listed in page 8 can be considered to be a different group),
and

wherein the rule judge determines a rule that belongs to a group in accordance with the updated time unit as the rule applicable when the video game advances (the game program determines a rule group belong to the active group according with the updated time unit when the rule is set "on" as described in page 8, and when the rules are effective during the play. I.e., "3 in the key" is applicable when the "3 in the key" is set "on", and the offense player has the ball within the free throw lane.).

Claim 27. The video game apparatus according to claim 23, wherein a number of rules applicable when the video game advances is at least two, and wherein the rule judge increases the number of rules applicable when the video game advances (When the player has the ball, the out of bound and backcourt rules are in effective.

Throughout the game play, if the player's character advances to the free throw lane, the "3 in the key" rule is also in effect.).

Claim 28. The video game apparatus according to claim 23,
wherein the instruction input device inputs an instruction to operate a player character (page 2),

wherein the video game apparatus further comprises a characteristic value storage that stores a characteristic value of the player character that varies as the video game progresses (As the game progress, the player character can have the characteristic of "possession of the ball".), and wherein the penalty processor varies the stored characteristic value of the player character (Player can lose possession of the ball as a penalty.).

Claim 29. The video game apparatus according to claim 28,
wherein multiple player characters can be controlled from the instruction input device (The switch players allow the player to controller multiple player characters, page 3.),

wherein the rule violation determiner judges a player character that violates the determined rule based on the instruction to operate the player character, and wherein the penalty processor imposes the predetermined penalty on the player character that violates the rule (see rejection for claim 23).

Claim 30. The video game apparatus according to claim 23, wherein the player character can execute multiple types of operations (player can operate offense and defense operations, pages 2-3), wherein the instruction input device inputs a type of operation to be executed by the player character, and wherein the penalty processor limits the types of operations that can be executed by the player character to impose the penalty (The lost possession of the ball penalty prevents the player to perform "Offense-with the ball" operations, page 2).

Claim 31. The video game apparatus according to claim 30, wherein multiple player characters can be controlled from the instruction input device, wherein the rule violation determiner judges a player character that violates the determined rule based on the instruction to advance the video game, and wherein the penalty processor imposes the predetermined penalty on the player character that violates the rule (If the player character with the ball violates a rule, the player character loses possession of the ball, page 8).

Claim 32. The video game apparatus according to claim 23, further comprising: an item storage that stores items provided to the player as the video game progresses (As the game progresses to and offense play, the player has possession of the ball. The ball is provided to the player through the offensive characters), and wherein the penalty processor deletes a predetermined item stored in the item storage to impose the penalty (the player character loses possession of the ball).

Claim 34. A video game apparatus according to claim 23, further comprising:
a violation history storage that stores a history of determined violations, wherein the penalty processor imposes the predetermined penalty based on the stored history of violations (Game data such as violation is stored in the game system's memory. The penalty occur right after the violation is performed).

Claims 35-42. See rejections above.

Claim 43. A time unit of a virtual concept in the video game is updated in a non-cyclic manner (NBA discloses the time counts up for the quarter, counts down for a shot clock, pages 7 and 15. The time is updated as the time increases or decreases. This is considered to be non-cyclic manner because the time counts up or counts down).

Response to Arguments

Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive.

Regarding the 35 USC 112 first paragraph rejection, Applicants have clarified the term "foothold movement" by defining the term within the claim. Applicants argue that support for this limitation have been described in paragraphs 48-50. However, this term is not present in paragraphs 48-50, nor was it present in the originally filed claims. Therefore the term is considered to be new matter. Thus the 35 USC 112 first

paragraph rejection is maintained.

Applicants further argue that NBA Live does not teach the limitation of "updates a time unit when the player character moves between footholds". However this limitation can not be found in the claims. The claims recite "a rule storage that stores a rule to be set in accordance with the updated time unit independently of the foothold to which the player character is moved". This is interpreted as the storage of the rules in which are to be set as the time is updated. These rules that are stored to be set are independent of the foothold to which the player character is moved.

The limitations for the newly added claims 43 and 44 have been addressed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASSON H. YOO whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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